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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,439	03/09/2004	Gary Weller	SATTY 69244	4484

7590 10/29/2008  
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EXAMINER
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EREZO, DARWIN P

ART UNIT	PAPER NUMBER
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3773

MAIL DATE	DELIVERY MODE
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10/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/797,439	<b>Applicant(s)</b> WELLER ET AL.	
	<b>Examiner</b> Darwin P. Erez	<b>Art Unit</b> 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 44-60 and 100-117 is/are pending in the application.
- 4a) Of the above claim(s) 53-60 and 100-117 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/26/04, 5/26/04, 2/15/05, 8/24/05, 10/06/06, 3/26/07, 7/30/07, 7/30/07, 10/10/07.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species I in the reply filed on 7/10/08 is acknowledged. The traversal is on the ground(s) that the species are not mutually exclusive and that there is no burden to the examiner to search both species. This is not found persuasive because the pending claimed inventions are directed towards method claims. As such, the methodology of acquiring tissue from within a hollow body organ using a device without a septum would be mutually exclusive (different steps) from a method specifically using a septum in the process. Also, there will be a burden to the examiner to search both species because the methodology for Species I could be performed by a surgical stapler having an arm and an anvil, while the search for Species II would require search in additional subclasses to find a device having a septum (such as in the clip applier or suturing arts).

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 53-60 and 100-117 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/10/08.

***Information Disclosure Statement***

3. The information disclosure statement(s) (IDS) submitted on 4/26/04, 5/26/04, 2/15/05, 8/24/05, 10/06/06, 3/26/07, 7/30/07, 7/30/07, 10/10/07 have been received and made of record. Note the acknowledged form PTO-1449 enclosed herewith.

Applicant should note that the large number of references in the attached IDS have been considered by the examiner in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. **See MPEP 609.05(b).** Applicant is requested to point out any particular references in the IDS which they believe may be of particular relevance to the instant claimed invention in response to this office action.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 44-52 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,592,596 to Geitz.

As shown in the attached figure below, Geitz discloses a method of acquiring tissue from within a hollow body organ, comprising:

-positioning a first acquisition member and a second acquisition member adjacent to a region of tissue within the hollow body organ (see attached figure), wherein the first and second acquisition members are in apposition to one another along a first longitudinal axis in an open configuration;

-adhering tissue from the region within each of the first and second acquisition members;

-compressing the adhered tissue between the first and second acquisition members in a closed configuration (Fig. 7);

-fastening the adhered tissue between the first and second acquisition members with at least one fastener (see attached figure);

-removing the first and second acquisition members from the hollow body organ (after surgery);

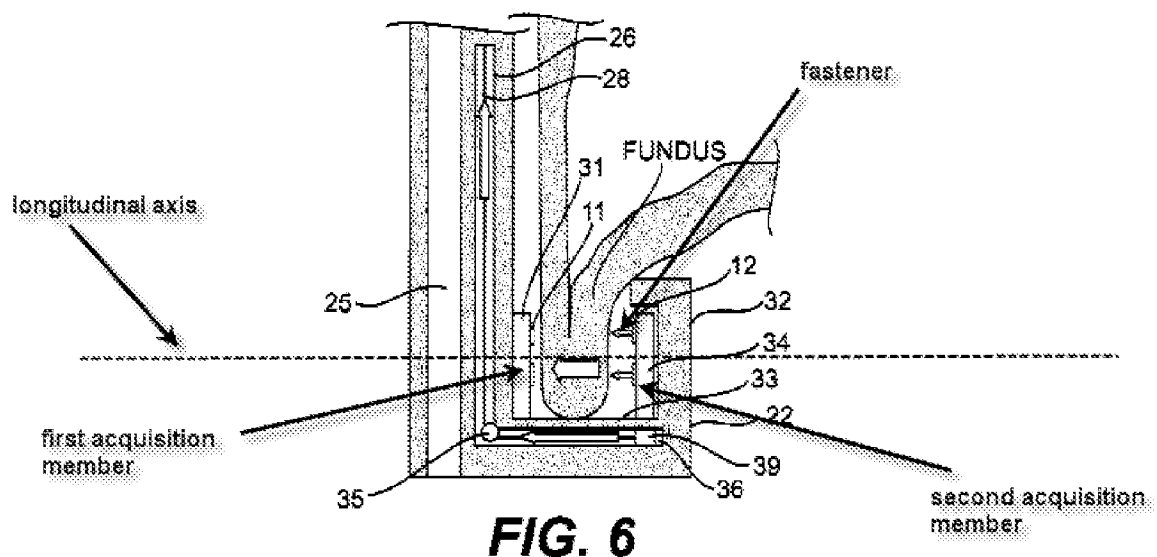
-advancing the first and second acquisition members transesophageally into the hollow body organ (during surgery);

-reconfiguring the first and second acquisition members from a closed configuration to an open configuration prior to positioning (transition from Fig. 6 to Fig. 7);

-wherein positioning the first acquisition member and the second acquisition member comprises aligning the members adjacent to a lesser curvature (distal end 22 has a lesser curvature and is adjacent the members);

-wherein adhering tissue comprises drawing tissue into each of the first and second acquisition members via a vacuum force (col. 5, ll. 64 – col. 6, ll. 14);

-wherein adhering tissue could be done simultaneously or sequentially to the first and second acquisition members.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erezzo whose telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erezzo/  
Primary Examiner, Art Unit 3773